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EXAMINER

LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,015

Applicant(s)

ELBERSE ET AL.

Examiner

Arrienne M. Lezak

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Examiner notes that Claims 1, 3, 10, 12, 15 and 18 have been amended, Claim 4 has been cancelled and no new Claims have been added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 23 February 2004 as enumerated herein below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 10, 12, 15 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, Examiner finds that the additional limitation of:

"said first web-entity having no information about any of the second web-entities"

to constitute new matter, as Applicant's specification, recites the following process:

"ii) forwarding an address of the second web-entity to the redirection server *from the web-browser* such that the redirection server redirects the web-browser to the second web entity"

Examiner notes that in order for the web-browser (which is implicitly of the first web-entity) to forward an address of the second web-entity, first web-entity would have to know said address. This reads on the first web-entity having information of the second

web-entity, contrary to the newly added limitation. Moreover, the claims as amended render the invention non-enabled, making an art rejection is not possible and thus, said Amended Claims have not been examined.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1, 10, 12, 15 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Examiner finds that the additional limitation of:

“said first web-entity having no information about any of the second web-entities”

to constitute new matter, as Applicant's specification, recites the following process:

“ii) forwarding an address of the second web-entity to the redirection server *from the web-browser* such that the redirection server redirects the web-browser to the second web entity”

Examiner notes that in order for the web-browser (which is implicitly of the first web-entity) to forward an address of the second web-entity, first web-entity would have to know said address. This reads on the first web-entity having information of the second web-entity, contrary to the newly added limitation. Moreover, the claims as amended render the invention non-enabled, making an art rejection is not possible and thus, said Amended Claims have not been examined.

6. Claims 1, 3 and 8 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, Examiner finds the intermingled

use of the terms web-entity and web-browser to be completely confusing and requiring clarification.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10 and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,870,546 to Kirsch.

9. Regarding Claims 10, 12, 15 and 18, Kirsch discloses a method, system, apparatus and computer program for using a web-browser to pass information from a first web-entity a second web-entity, (Abstract), said method comprising the steps of:

- receiving a pre-specified address of a redirection server, together with additional information, from the first web-entity at the web-browser, (Col. 11, lines 24-35);
- forwarding an address of the second web-entity to the redirection server from the web-browser such that the redirection server redirects the web-browser to the second web-entity, (Col. 11, lines 24-42); and
- passing the additional information from the web-browser to the second web-entity, (Col. 11, lines 24-42).

Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 10, 12, 15 and 18.

10. Regarding Claims 13, 14 and 17, Kirsch further discloses a communication network web-based information system, (per pending Claim 13), with at least one redirection server, (per pending Claim 14), wherein a web-entity is a web-server arranged to redirect the web-browser, (per pending Claim 17), (Col. 5, lines 25-67 and Col. 6, lines 1-10). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 13, 14 and 17.

11. Regarding Claim 16, Kirsch discloses a method wherein the address of the second web-entity is forwarded to the re-direction server in a cookie from the web-browser, (per pending Claim 16), (Col. 5, lines 25-67; Col. 6, lines 1-10; Col. 12, lines 19-64). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claim 16.

12. Regarding Claims 19 and 20, Kirsch discloses a method wherein cookies, (embedded objects) are generated for each of an information receiver, and a redirection server, said method comprising accessing the information receiver using the web-browser; and automatically redirecting the web-browser to the redirection server, (per pending Claim 19); and automatically redirecting the web-browser to one or more additional redirection servers, (per pending Claim 20), (Col. 5, lines 25-67; Col. 6, lines 1-10; Col. 12, lines 19-64). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 19 and 20.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,870,546 to Kirsch in view of US Patent 6,070,191 to Narendran.

15. Regarding Claim 1, Kirsch discloses a method, system, apparatus and computer program for using a web-browser to pass information from a first web-entity a second web-entity, (Abstract), said method comprising the steps of:

- receiving a pre-specified address of a redirection server, together with additional information, from the first web-entity at the web-browser, (Col. 11, lines 24-35);
- forwarding an address of the second web-entity to the redirection server from the web-browser such that the redirection server redirects the web-browser to the second web-entity, (Col. 11, lines 24-42); and
- passing the additional information from the web-browser to the second web-entity, (Col. 11, lines 24-42).

16. Though Kirsch does teach the passing of information from a first web-entity to a second web-entity, Kirsch does not specifically teach the passing of information from a first web-entity to a plurality of second web-entities.

17. Narendran discloses the passing of information from a first web-entity to a plurality of second web-entities, (Abstract and Col. 16, lines 48-59).

18. To incorporate the ability to pass information from a first web-entity to a plurality of second web-entities into the Kirsch invention would have been obvious to one of ordinary skill in the art at the time of invention by Applicant, as noted within the very nature of a redirection server. In particular, the ability to redirect information using a server allows one to forward information, as needed, to a resource capable of performing a given operation on said information. It would be obvious, (in light of the ability to redirect one set of information, as noted within Kirsch), to redirect numerous sets of information as user needs require.

19. Examiner further notes that the Narendran invention specifies the redirection of information to document servers, however, Examiner believes the incorporation of other databases maintaining telephone and television program information would also have been obvious in light of the teaching of a document database generally. In other words, the nature of the database is non-determinative of Applicant's invention and thus the substitution of Applicant specified database information into an invention disclosing a database property is obvious and thus, not novel. Therefore, Claim 1 is considered unpatentable over the combined teachings of Kirsch in view of Narendran.

20. Regarding Claims 2 and 3, Kirsch and Narendran are relied upon for those teachings disclosed herein above. Kirsch further discloses a communication network web-based information system, (per pending Claim 2); wherein a web-entity is a web-server, (information receiver), arranged to redirect the web-browser, (per pending Claim

3), (Col. 5, lines 25-67 and Col. 6, lines 1-10). Therefore, Claims 2 and 3 are unpatentable over the combined teachings of Kirsch in view of Narendran.

21. Regarding Claims 5-7, 9 and 11, Kirsch and Narendran are relied upon for those teachings disclosed herein above. Kirsch further discloses a method wherein additional information and the address of the second web-entity is forwarded to the redirection server, (per pending Claim 5); wherein additional information comprises a telephone number and the second web-entity is a node in a telecommunications network, (per pending Claims 6 and 11); wherein the additional information comprises television program information and the second web-entity is a video recorder, (per pending Claim 7); and wherein said additional information comprises instructions for an action to be performed at the second web-entity, (per pending Claim 9), (Col. 6, lines 36-67 and Col. 7, lines 1-57).

22. As noted herein above, Examiner finds the use of particular-type database information, such as but not limited to: telephone number lists, television program information, and any and all instruction for performance of further actions, to be obvious in light Kirsch. Examiner further finds that the same argument may be made concerning network type, as applied to Applicant's invention. In other words, the use of a telecommunications network would have been obvious in light of the communications network disclosed in Kirsch. Moreover, Kirsch discloses the redirection of data generally, which data encompasses those types specified by Applicant. Therefore, Claims 5-7, 9 and 11 are found to be unpatentable over the combined teachings of Kirsch in view of Narendran.

23. Regarding Claim 8, Kirsch and Narendran are relied upon for those teachings disclosed herein above. Kirsch further discloses a method wherein the address of the second web-entity is forwarded to the re-direction server in a cookie from the web-browser, (per pending Claim 8), (Col. 5, lines 25-67; Col. 6, lines 1-10; Col. 12, lines 19-64). Therefore, Claim 8 is also found to be unpatentable over the combined teachings of Kirsch in view of Narendran.

Response to Arguments

24. Applicant's arguments filed 22 April 2004, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

25. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "said first web-entity having no information about any of the second web-entities") is not recited in the rejected claim(s). Further, as noted above, those amended claims containing said features are rejected as being in violation of **35 USC § 112**, and as such, have not been examined as amended.

26. Examiner again notes that Applicant's failure to make a distinction between "web-entity" and "web-browser" on a client, (as recommended by Examiner in the first office

action dated 23 February 2004), renders the same confusing and difficult to interpret. Further, Examiner notes that a web-server and a web-browser are both web-entities. Thus, Examiner finds that a server, such as that redirected to, (in Kirsch), reads upon Applicant's claims. Moreover, as noted herein, Examiner remains confused by Applicant's arguments concerning web-browsers as information receivers as well as the intermingled use of the terminology "web-entities, web-browsers, and web-servers" generally as noted herein. As such, Examiner is unable to respond to Applicant's arguments concerning the same. Examiner will note, however, that "additional information" could be any data, (Col. 7, lines 24-29). Finally, Examiner notes that mere recitation that the redirection server has no knowledge about second web entities is still addressed by Narendran, which uses a statistical approach to routing redirections.

27. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amendments and reconsideration of the same avoids such references or objections, Examiner hereby maintains the original rejection of all claims in their entirety.

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

29. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (703)-305-0717. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703)-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703)-305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-6121.

Arrienne M. Lezak
Examiner
Art Unit 2143

AML


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